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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/765,774

01/27/2004

Newton James Smith JR.

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2460

7590

03/23/2005

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/765,774

Applicant(s)

SMITH ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12-13-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-12,14-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-12,14-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 3 February 2005.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 2, 4, 5, 8, 11, 12, 14, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golasinski et al. (US 2003/0097332) in view of Hoyos et al. (US 2002/0082993).

Re claim 1, Golasinski et al. teaches displaying a list of payees to a customer in response to a customer request to pay a bill at a remote terminal location and identifying a payee from a customer selection of a payee from the display list of payees (paragraph [0028]). Golasinski et al. teaches receiving customer payment information for the

selected payee by prompting the customer to submit payment account information (paragraph [0029]). Golasinski et al. teaches receiving a payment/check from the customer (paragraph [0032]). Golasinski et al. teaches submitting the received payment to the selected payee as it proceeds as an ACH transaction (paragraph [0035]). Golasinski et al. teaches a receipt (28). Re claim 2, Golasinski et al. teaches the payment instrument is a check (FIG. 2B). Re claim 4, Golasinski et al. teaches prompting the customer to submit payment account information (paragraph [0029]). Re claim 8, Golasinski et al. teaches submitting a written paper check, as discussed above. Though Golasinski et al. is silent to creating an electronic version of the check, Golasinski et al. teaches converting the check to an ACH transaction (abstract). This is broadly interpreted as an electronic version of the check that is submitted to the payee for payment. In instances of normal operating hours of a bank/financial institution, such a transaction is known to be submitted for immediate payment. Re claim 9, Golasinski et al. teaches a written check is submitted (see above), that the instrument is stored in a location in the terminal for the payee (it is stored in the remote

Re claim 1, Golasinski et al. is silent to submitting customer's selection of an electronic or manual payment plan, as Golasinski et al. teaches manual or electronic payment. Re claim 5, Golasinski et al. is silent to the payee information submission step further comprising inserting a customer statement from the designated payee.

Re claim 1, Hoyos et al. teaches a bill payment machine that accepts both check and card payment (manual and electronic plans) (paragraph [0004+]). Re claim 5, Hoyos et al. teaches that a customer statement can be inserted in order to identify bill information, including account and payee information (abstract)

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Golasinski et al. with those of Hoyos et al.

One would have been motivated to do this to provide for additional ways to pay for bills, while permits recognition of payees to ensure reliability.

Re claims 11, 12, 14, 15, 16, and 18, the limitations have been discussed above.

3. Claims 9-10 and 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Golasinski et al./Hoyos et al., as discussed above, in view of Riach et al. (US 5,751,842).

The teachings of Golasinski et al./Hoyos have been discussed above.

Golasinski et al./Hoyos are silent to a receipt containing a copy of the transaction including a scanned check image, the name of the payee, the amount of the payment, and the date and time of the payment.

Riach et al. teaches such limitations (FIG. 7).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Golasinski et al./Hoyos with those of Riach et al.

One would have been motivated to do this to provide a detailed receipt of the transaction.

The Examiner interprets that the payment can be a pending submission of a paper transaction, because the Examiner notes that not all banking/check transactions are processed immediately, as those that are completed after banking hours, on a Sunday, etc. (for example) will not post immediately (the next business day; as is well known and

conventional in the art). In such instances, the receipt does indeed notify about the pending submission of a paper transaction, as it has not yet occurred.

### ***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shuster (US 2002/0082926) and Dutta et al. (US 2002/0152165).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

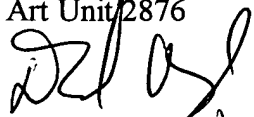
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh  
Examiner  
Art Unit 2876



Daniel Walsh



KARL D. FRECH  
PRIMARY EXAMINER